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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Stephen A. Lindia, et al.	
Application No.: 09/870,865	Group Art Unit: 3623
Filed: May 31, 2001	Examiner: J.R. Loftis
For: EMPLOYEE PERFORMANCE MONITORIING SYSTEM	
Atty. Docket No.: GOL101.10009	

I, John F. Letchford, Registration No. 33,328, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 2, 2006.

John F. Letchford

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Sir:

APPELLANTS' BRIEF PURSUANT TO 37 CFR § 41.37

The above-identified application comes before the United States Patent and Trademark Office ("USPTO") Board of Appeals and Interferences ("Board") from a Final Rejection of claims 10-18 dated October 17, 2005.

I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Goldman, Sachs & Company, a partnership formed under the laws of the State of New York with its principal place of business located at 85 Broad Street, New York, NY 10004, USA ("Assignee"), as evidenced by an assignment of the entire right, title and interest in and to the application from the inventors, Stephen Lindia and Simeon Morfe, to Assignee, which is recorded in the USPTO at reel 012217 and frame 0376.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, Assignee or the undersigned which will directly affect or be directly affected by or have a bearing on the Board's decision in the presently pending appeal.

III. STATUS OF THE CLAIMS

The status of the claims in the application is as follows:

Original claims 1-9 have been canceled. Claims 10-18 remain in the application and are finally rejected.

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO THE FINAL REJECTION

An "After-Final" Amendment was filed on January 12, 2006. The Amendment was entered for purposes of appeal. A Notice of Appeal, a Pre-Appeal Request for Review and arguments in support thereof were filed on February 6, 2006. A Notice of Panel Decision from Pre-Appeal Brief Review was issued by the USPTO on February 24, 2006. The Notice of Panel Decision indicated that

the application remains under appeal because there is allegedly at least one actual issue for appeal. This Brief is timely filed within one month of the Notice of Panel Decision.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Most broadly, the invention defined in the claims on appeal is addressed to a method for conducting an employee performance review program on a computerized system. The claims on appeal include one (1) independent claim, claim 10, and eight (8) dependent claims, Claims 11-18.

The method recited in independent claim 10 on appeal involves (with reference to specification page and line numbers and drawing reference characters, where available, in parentheses):

selecting, by a user of the system, a person whose employment performance the user desires to review but is not obligated to review (specification at page 3, lines 17-30; page 4, lines 22-26; page 5, lines 13-16; page 7, line 16 through page 8, line 11; page 11, lines 22-27; page 22, lines 1-7 and lines 26-30; and the Abstract of the Disclosure; drawing FIGS. 12-17 generally and drawing ref. no. 188 specifically);

inputting employee performance review information into the system by the user (drawing FIGS. 1-11 and 17 and attendant specification text);

processing employee performance review information input into the system by the user (specification at page 14, line 32 through page 15, line 8; and drawing ref. nos. 20 and 212); and

storing employee performance review information input into the system by the user (specification at page 12, lines 22-30; page 36, lines 25-31).

Claims 11-18 on appeal further enlarge upon the method of claim 10 to define various features which are believed to be representative of preferred aspects thereof.

The invention claimed in the claims on appeal provides a novel method for conducting an employee performance review program which offers reviewers the unique ability to review the performance of reviewees whose performance they desire to review but are not obligated to review (i.e., the performance of reviewees that have not nominated or requested the reviewers to review them).

Presently existing methods for conducting employee performance reviews were discussed at length at pages 1-4 in the specification of the present application as well as during prosecution thereof. However, none of these methods or systems, including that disclosed in the reference cited against the claims on appeal, is capable of producing the advantages afforded by the claimed invention now before the Board.

As will be clearly demonstrated herein, the method defined in all of the claims on appeal is neither disclosed nor suggested, either expressly or implicitly, by the reference relied upon by the Examiner.

VI. GROUNDS OF OBJECTION/REJECTION TO BE REVIEWED ON APPEAL

A statement of each separate ground of objection or rejection Appellants wish to be reviewed, including the basis of each ground of rejection, is as follows:

(1) Claims 10-18 remain in the present application. Claims 10-14 and 16-18 stand finally rejected under 35 U.S.C. § 102(a and e) as being anticipated by Dirksen, et al. (U.S. Patent No. 6,853,975, "Dirksen").

(2) Claim 15 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Dirksen.

VII. ARGUMENT

(1) Rejection of Claims 10-14 and 16-18 under 35 U.S.C. §§ 102(a and e)

Claims 10-14 and 16-18 stand rejected under 35 U.S.C. §§ 102(a and e) as being clearly anticipated by. Such rejection is respectfully traversed.

For the Board's convenience, sole independent claim 10 on appeal is reproduced herebelow, with emphasis added.

> 10. (Currently Amended) A method for conducting an employee performance review program on a computerized system, said method comprising the steps of:
>
> selecting, by a user of the system, a person whose employment performance the user desires to review but is not obligated to review;
>
> inputting employee performance review information into the system by the user;

processing employee performance review information input into the system by the user; and storing employee performance review information input into the system by the user.

At several locations throughout the Final Office Action (Mail Date: October 17, 2005) the Examiner asserted: "In light of the specification, and for purposes of examination, the claims are construed to mean that a user is not obligated to review the performance of another person just because the person is listed for potential review." (emphasis added). At the first of those instances (the final sentence of the paragraph bridging pages 2 and 3 of the Final Office Action), the Examiner followed that statement with: "Prior rejections under Dirksen are upheld, but modified to reflect the new understanding of the claims." These statements serve as the foundation for the Examiner's final rejections of the claims.

A unique aspect of the present invention is that it permits persons (reviewers) who desire to review the job performance of other persons (reviewees) to do so without obligation to do so. That is, persons who have not been chosen by a reviewee to review the reviewee may nonetheless do so if they so desire. This capability is expressly set forth in independent claim 10 wherein it is stated: "selecting, by a user of the system, a person whose employment performance the user desires to review but is not obligated to review." A significant advantage afforded by this feature is that it permits individuals who may have substantial knowledge of a person's employment performance, e.g., persons from within and outside of a person's employment department, to provide input that may be useful in evaluating that person even if the reviewee had not selected those persons

to review his or her performance. Dirksen is utterly silent as to this unique functionality.

What the Examiner fails to appreciate is that Dirksen enables reviewees to select their reviewers but does not permit reviewers to select their reviewees. In this respect Dirksen is no different than the commercially available 360° Feedback® and the Visual 360® so-called "360°" employee review systems discussed at length in the "Background of the Invention" section of Appellants' specification.

The Examiner has unyieldingly relied upon column 4, lines 55-61 of Dirksen as basis for her belief that Dirksen discloses the unique limitation of Appellants' independent claim 10 which now reads: "selecting, by a user of the system, a person whose employment performance the user desires to review but is not obligated to review." That passage from Dirksen is reproduced below (with emphasis added).

> Once the rater nominations have been submitted and approved by a manager, the approved raters may initiate the rating process. However, the approved raters must first complete the previously described training process prior to initiating the rating process. Once the training process is completed, the rater may enter the rating system, and referring to FIG. 16, the rater may select from screen 124 the name 126, 128 of the person he or she wishes to rate.

The Examiner's rendering of this passage is skewed because it is taken out of the remaining context of the Dirksen patent. With due respect, the Examiner does not appear to appreciate the significance of the underscored portion of the foregoing passage. It is the ratees (reviewees) who first nominate or

select raters (reviewers) to review the ratees' performance. See Dirksen at column 1, lines 50-53; column 2, lines 8-11 and the Abstract. The nominees are then approved or disapproved by a ratee's manager. See Dirksen at column 1, lines 53-54; column 3, lines 8-24. These are conventional steps already performed by conventional "360°" employee review systems.

Following management approval of selected raters, the nominated raters are obligated to rate all of the ratees for whom they have been approved to rate.

> Turning to FIG. 21, screen 166 signifies the end of the ratings process, and box 168 is provided for submitting optional comments regarding the employee being rated. In screen 170 of FIG. 22, all ratings may be submitted by selecting box 172, thus completing the *duties* of the rater.
>
> Dirksen at column 5, lines 12-16 (double emphasis added).

It is quite clear from the foregoing that the nominated rater is duty-bound or obligated to review only the ratees who have nominated him or her to do so. A rater cannot independently select other persons to review.

Nowhere does Dirksen expressly or impliedly disclose or suggest that potential raters have the choice to review persons who have not nominated them for review. Indeed, what Dirksen does teach is conventional and the antithesis of that specifically called for in Appellants' independent claim 10.

(2) Rejection of Claim 15
under 35 U.S.C. § 103(a)

Claim 15 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Dirksen. Such rejection is respectfully traversed.

Since Dirksen fails to disclose or suggest the invention recited in independent claim 10, as a matter of law, it likewise fails to render obvious the narrower version thereof specified in dependent claim 15. If an independent claim is not infringed, the claims that depend therefrom cannot be infringed. *Eltech Systems Corp. v. PPG Industries Inc.*, 710 F. Supp. 622, 634, n.10, 11 USPQ2d 1174 1184, n.10 (W.D. La.1988), *aff'd*, 903 F.2d 805, 14 USPQ2d 1965 (Fed. Cir. 1990)("By definition, if the claim to which the dependent claim refers is not infringed, the dependent claim cannot be infringed, as a matter of law.")

For the foregoing reasons, Appellants submit that Dirksen fails to anticipate or render obvious the present invention as claimed in claims 10-18. Indeed, in several critical respects Dirksen leads one of ordinary skill in the art directly away therefrom. Accordingly, Appellants kindly submit that the outstanding rejection of claims 10-14 and 16-18 under 35 U.S.C. 102(a and e) as being anticipated by Dirksen and the rejection of claim 15 as being obvious over Dirksen are improper and should be reversed.

Appellants respectfully offer that this particular solution to this particular problem is neither disclosed nor suggested, either expressly or impliedly, by Dirksen. Indeed, Appellants reiterate that it was because of the shortcomings of

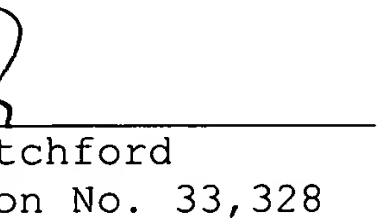
the prior art such as that taught by Dirksen which inspired Appellants to conceive and develop the presently disclosed and claimed solution to the problem.

To conclude, Appellants' claims must be interpreted fairly and accurately. For reasons hereinabove noted, the teachings of Dirksen must be fairly and accurately interpreted for what they in fact disclose and/or suggest. The disclosures of Dirksen, when so interpreted, do not disclose or suggest Appellants' claimed invention. Therefore, the invention as a whole would not have been considered obvious to one skilled in this art at the time of Appellants' invention. Accordingly, it is respectfully submitted that the Final Rejection of claims 10-18 should be reversed.

Respectfully submitted,

Stephen Lindia, et al.

Date: March 2, 2006



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VIII. APPENDIX

The claims on appeal are as follows:

10. A method for conducting an employee performance review program on a computerized system, said method comprising the steps of:

selecting, by a user of the system, a person whose employment performance the user desires to review but is not obligated to review;

inputting employee performance review information into the system by the user;

processing employee performance review information input into the system by the user; and

storing employee performance review information input into the system by the user.

11. The method of claim 10 further comprising the step of selecting, by the user, at least one of himself, a superior, a peer, a subordinate and a client to review the user's employment performance.

12. The method of claim 11 said inputting step comprises inputting of said employee performance review information over a communication network.

13. The method of claim 12 wherein the communication network is the Internet.

14. The method of claim 12 wherein the communication network is a business enterprise intranet.

15. The method of claim 12 further comprising inputting said employee performance review information by the user while the user is disconnected from the communication network.

16. The method of claim 11 further comprising requiring approval by the user's manager of persons selected by the user to review the user's employment performance and persons selected by the user whose employment performance the user desires to review but is not obligated to review prior to processing and storage of employee performance review information input into the system by the user.

17. The method of claim 11 further comprising preloading into said storage means a roster of persons with whom the user has had substantial employment related interaction during a relevant review period, wherein said roster of persons includes persons that may be selected by the user to review the user's employment performance and persons that may be selected by the user whose employment performance the user desires to review but is not obligated to review.

18. The method of claim 17 further comprising entering additional persons into said roster by the user.

IX. EVIDENCE APPENDIX

NONE.

X. RELATED PROCEEDINGS APPENDIX

NONE.

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